

BULLIED, Neil J.  
Appl. No. 10/632,847  
October 31, 2007

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REMARKS/ARGUMENTS

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Reconsideration of this application and entry of the foregoing amendments are respectfully requested.

Claims 28-37 and 39-43 stand rejected as allegedly representing obviousness-type double patenting over claims 1-3, 5, 6, 12, 13 and 17-19 of Bulleid et al (USP 6,171,827). Withdrawal of the rejection is in order for the reasons that follow.

The instant claims are drawn to a production method. That method requires that a first procollagen be produced in a cell that expresses and assembles a second procollagen. As pointed out previously, no such cell is taught by the claims of USP 6,171,827. Furthermore, the instant claims require the expression in the cell of nucleic acid sequence(s) that encode(s) a pro- $\alpha$  chain for assembly into the first procollagen, which nucleic acid sequence(s) do/does not encode pro- $\alpha$  chain(s) that co-assemble with the pro- $\alpha$  chains that assemble to form the second procollagen. The Examiner's apparent assertion to the contrary, nothing in the cited patent claims are even suggestive of this further requirement.

The Examiner's rejection appears to be based on that which the Examiner views to be inherent in the Bulleid et al claims. The Examiner is reminded, however, that "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). No such basis in fact and/or technical reasoning has been provided here. Accordingly, reconsideration is requested.

Claims 28-33 and 35-43 stand rejected under 35 USC 102(e) as allegedly being anticipated by Bulleid et al. The rejection is traversed.

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The Examiner appears to have again overlooked the requirements in the instant claims relating to the nature of the host cells used and the nucleic acid sequence expressed (see comments above responsive to the rejection based on obviousness-type double patenting). These requirements are not taught by citation.

Further, the Examiner is reminded of the statement by the Board in *Ex parte Levy* (quoted above) regarding the basis/reasoning that an examiner is required to provide when relying upon a theory of inherency. No such basis/reasoning has been provided here.

Reconsideration is requested.

Claims 28-33 and 35-42 stand rejected under 35 USC 102(f). The rejection is clearly based on the Examiner's misunderstanding of the reference (see comments above). The Examiner is requested to provide proper basis for the rejection or withdraw same.

Reconsideration is thus requested.

Claims 28-44 stand rejected under 35 USC 103 as allegedly being obvious over Bullied et al as evidenced by Barr et al. It is respectfully submitted that the Examiner has again overlooked the fundamental failings of the primary reference (see comments above). Nothing in Barr et al would have cured those failings. Accordingly, reconsideration is requested.

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This application is submitted to be in condition for allowance and a Notice to that effect  
is requested.

Respectfully submitted,

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